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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/648,033 08/25/00 PATEL

M 112703-017

EXAMINER

IM52/0216

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ART UNIT	PAPER NUMBER

1761
DATE MAILED:

02/16/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. <u>09648,033</u>	Applicant(s) <u>DATEL ET AL</u>
Examiner <u>ARTHUR L. CORBIN</u>	Group Art Unit <u>1761</u>

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 11-14-00 IDS
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-20 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 5-20 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

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DETAILED ACTION

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 11, 17, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no antecedent basis in claim 1 for "the elastomer", "the softener" or "the emulsifier" (claim 2) and in claim 18 for "the chewing gum formulation" (claim 18) and the water soluble portion" (claim 20).

Further each of claims 2, 11 and 17 does not further limit the claim from which each depends, i.e. claim 1, 8 and 14, respectively. In each of claims 2, 11 and 17 the range of emulsifier is not within the range for the lecithin recited in claims 1, 8 and 14, respectively.

Corrections are required without new matter.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-6 and 14-20 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by *for 6 to 103 not new* *new gd* *4,518,615* Cherukuri et al (~~4,518,615~~ cols. 5 and 6 and Table III Run D), Cherukuri et al (4,794, 003, cols. 2, 6, 7 and 8) or D'AMELIA et al (cols. 3, 5, 6 and 10).

Each reference discloses a sugar-free chewing gum composed of a chewing gum base including an elastomer, a softener, an emulsifier, up to 10% lecithin, an elastomer solvent and a resin as claimed in applicant's claim 5. Each component is present in an amount as claimed by applicant. Each disclosed gum base is absent a filler. Further, when the gum base is mixed with the water soluble portion in each patent, lecithin will be added to the water soluble portion.

6. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri et al (4,518, 615), Cherukuri et al (4,794,003) or D'AMELIA et al. Finding the optimum amount of lecithin to include in the gum base would require nothing more than routine experimentation by one reasonable skilled in this art.

7. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cherukuri et al (4,518,615), Cherukuri et al (4, 794, 003) or D'AMELIA et al in view of Klose et al.

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It would have been obvious to include an antioxidant and colorant in the gum base of each primary reference since such components are conventional in gum bases containing no added fillers and including lecithin, as evidenced by Klose et al (cols. 2 and 6).

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thornton*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of copending Application No. 09/648,028 in view of Cherukuri et al (4,518,615), Cherukuri et al (4,794,003) or D'AMELIA et al. It would have been obvious to include lecithin in the gum base claim^{ed} in 09/648,028 since lecithin is a conventional component of chewing gum bases, as evidenced by each secondary reference.

This is a provisional obviousness-type double patenting rejection.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Corbin whose telephone number is (703) 308-3850. The examiner

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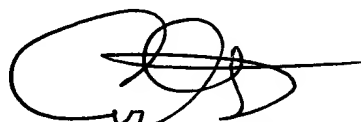
can normally be reached on Monday-Thursday from 9:30 AM to 7:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gabriella Brouillette, can be reached on (703) 308-0756. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-3602.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Corbin/af

February 14, 2001


ARTHUR L. CORBIN
PRIMARY EXAMINER
2-15-01